



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/981,803	10/19/2001	Francis Blanche	03804.0135-02000	6741

7590 08/20/2003

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.
1300 I Street, N.W.
Washington, DC 20005

EXAMINER

PRIEBE, SCOTT DAVID

ART UNIT	PAPER NUMBER
----------	--------------

1632

12

DATE MAILED: 08/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/981,803

Applicant(s)

BLANCHE ET AL.

Examiner

Scott D. Priebe

Art Unit

1632

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4,9-16,18,23-28,31-33 and 38-55 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 4 and 55 is/are allowed.
- 6) ☒ Claim(s) 9-11,14-16,18,23,24,26-28,31-33,38-46 and 48-52 is/are rejected.
- 7) ☒ Claim(s) 12,13,25,47,53 and 54 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

The amendment filed 6/17/03 has been entered. Claims 1-3, 5-8, 17, 19-22, 29, 30, and 34-37 have been cancelled. Claims 4, 12, 13, 24, 26 and 43 have been amended.

The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not). The applicant was filed with claims 1-54, any added claims should have commenced with claim 55.

Misnumbered claim 57 has been renumbered 55. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Priority

Applicant's arguments pertaining to foreign priority filed 6/17/03 have been fully considered but they are not persuasive. The priority claim to the French application is made under 35 USC 119(a)-(d), not 35 USC 120. The requirements of these two statutes differ in several respects, not just the commonality of inventorship.

Claim Rejections - 35 USC § 112

Claims 18, 31-33, 38-41, and 49-51 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 18 recites the limitation "[T]he plasmid according to claim 17" in line 1. There is insufficient antecedent basis for this limitation in the claim, because claim 17 has been cancelled.

Claims 31-33 recite the limitation "[T]he cultured recombinant cell according to Claim 30" in line 1. There is insufficient antecedent basis for this limitation in the claim, because claim 30 has been cancelled.

Claim 38 recites the limitation "[T]he method according to claim 37" in line 1. There is insufficient antecedent basis for this limitation in the claim, because claim 37 has been cancelled. This rejection also applies to claims 39-41, which also depend from cancelled claim 37 through claim 38.

Claim 49 recites the limitation "[T]he method according to claim 34" in line 1. There is insufficient antecedent basis for this limitation in the claim, because claim 34 has been cancelled. This rejection also applies to claims 50 and 51, which also depend from cancelled claim 34 through claim 49.

Claims 18, 31-33, 38-41, and 49-51 could be examined no further on the merits due to the lack of context, i.e. lack of a base claim, for the limitations. Rejections of these claims under other statutes have been withdrawn for this reason, but may be re-instated if warranted due to subsequent amendment of these claims

Claim Rejections - 35 USC § 102

Claims 23 and 24 remain rejected under 35 U.S.C. 102(b) as being anticipated by Black (Gene 46: 97-101, 1986) for the reasons set forth in the Office action of 12/17/02.

Claims 23, 24 and 26 remain rejected under 35 U.S.C. 102(b) as being anticipated by Peredelchuk et al. (Gene 187 (2): 231-238, 18 March 1997) for the reasons set forth in the Office action of 12/17/02.

Applicant's arguments filed 6/17/03 have been fully considered but they are not persuasive. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., transcription promoter and terminator active in mammalian cells) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Claims 23 and 24 do not depend from claim 9. Also, the claims recite merely "expression cassette" without limiting its contents, and the claims do not exclude antibiotic resistance from the expression cassette. In addition, with respect to claim 24, any of the lambda genes meet the limitation of being the expression cassette, which is separated by attR and attL from the ori and antibiotic resistance. The limitation "outside the expression cassette", does not exclude embodiments where the attR and attL flank the expression cassette and the ori or selection marker gene. This limitation only excludes the selection marker gene from being expressed from the expression cassette. In the case of Peredelchuk, one antibiotic resistance gene meets the limitation of selection marker gene and the other meets the limitation of expression cassette.

Double Patenting

Claims 9-11, 14-16, 23, 24, 26-28, 42-44, and 48 remain rejected and claim 52 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18, 24, 25, 28-37 of U.S. Patent No. 6,143,530 in view of Backman, EP 0160571, for the reasons set forth in the Office action of 12/17/02. In the original rejection, claim 49 was mistakenly rejected, as it depends from claim 34. Claim 52, which depends from claim 42, recites the same limitation and should have been rejected instead of claim 49.

Claims 42-46 remain rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 34 and 37 of U.S. Patent No. 6,143,530 and Backman, EP 0160571 as applied to claims 42-45 above, and further in view of Bigger et al. (J. Biol. Chem. 276 (25): 23018-23027, 22 June 2001).

Applicant's arguments filed 6/17/03 have been fully considered but they are not persuasive. See MPEP 804, section II.B.1. Whether the claimed invention is obvious over the patented invention in view of the prior art pertains to time the claimed invention was made, not at the time the patented invention was made.

Allowable Subject Matter

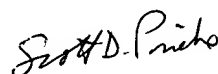
Claims 12, 13, 25, 47, 53, and 54 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Art Unit: 1632

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott D. Priebe whose telephone number is (703) 308-7310. The examiner can normally be reached on M-F, 8:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Clark can be reached on 703 305-4051. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4242 for regular communications and (703) 308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.



Scott D. Priebe
Primary Examiner
Art Unit 1632